

Appl. No. 10/540,943
Amdt. dated June 16, 2010
Reply to Office action of December 17, 2009

REMARKS

Claims 18-24, 26, 28-30, 36, and 37 are present in this application. Claims 1-17, 25, 27, 31-35, and 38-41 have been canceled. Claim 18 is the only independent claim. All claims except claim 30 have been amended, and the claims have been amended so as to be limited to the embodiment illustrated in Figure 5. No new matter has been entered.

Applicants would like to thank the examiner for the thorough consideration and examination give to this application. Applicants would also like to thank the examiner for his suggestion of claim language on page 4 of the Official Action. The suggested language has been added to claim 18.

The Declarations Under 37 CFR 1.131

Before addressing the substance of the invention, applicants would like to request that the examiner reconsider his holding that the declarations under 37 CFR 1.131 are deficient. These declarations were submitted with the RCE on May 11, 2009. The examiner states that the declarations are deficient because the fail to establish that the work was done after January 1, 1996. In response, applicants respectfully point out that this requirement is not part of the rule. 37 CFR 1.131(a) merely states that "prior invention" (i.e. reduction to practice) may not be established prior to January 1, 1996, in a WTO country, but it says nothing about the timing of the work leading up to the invention. Furthermore, MPEP 715 states:

"Acts occurring prior to the effective **dates** of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a

Appl. No. 10/540,943
Amdt. dated June 16, 2010
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NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.” (emphasis added)

In addition, paragraph (b) of the rule allows applicants several options for proving prior invention, as follows:

(b)The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. (emphasis added)

Accordingly, it is respectfully submitted that applicants’ declarations establish conception of the invention prior to 6 December 2002 along with due diligence to the filing of their German application and, thus, antedate the filing date of December 6, 2002.

If the examiner disagrees and continues to assert that the affidavits are insufficient to antedate the filing date of December 6, 2002, applicants respectfully request that the examiner provide support for his position.

On the other hand, if the examiner agrees that the affidavits are sufficient but they cannot be relied upon to overcome Harenbrock ‘571 because Harenbrock is claiming the same patentable subject matter as one or more of applicants’ claims, it is respectfully requested that the examiner point out which claim or claims he feels are claiming the same patentable invention.

The Rejections

Claims 18, 20, 24, 26, 30, and 39-41 stand rejected under 35 USC 102(b) as being anticipated by JP 63-258606. Regarding claim 18, it is respectfully submitted that the

Appl. No. 10/540,943
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amendments to claim 18 now clearly define over JP '606. Apparently, the examiner is treating the section of the filter immediately above the membrane 7 as the sump and the section below membrane 7 as the container. However, claim 18 now requires an outlet through which water drains from the sump, and a valve which opens and closes the water outlet. Clearly, there is no closable opening between the area above membrane 7 and the area below it. In the rejection, the examiner alleges that the membrane acts as a valve. However, applicants respectfully submit that it does not. It acts as a filter which prevents passage of fuel but allows water to flow through and drop into liquid layer 81. See the "Constitution" on the last page of the Japanese document. There is no provision in JP '606 for shutting off the flow of water through membrane 7. Therefore, it is respectfully submitted that membrane 7 cannot be reasonably said to be a valve. Accordingly, applicants submit that claim 18, as well as its dependent claims, clearly defines over JP '606, and they respectfully request the examiner to withdraw this rejection.

Claims 18, 21, 26-30, 32, and 38-41 stand rejected under 35 USC 102(e) as being anticipated by Harenbrock (6893571).

In light of the 37 CFR 1.131 declarations discussed above, it is submitted that neither Harenbrock '571 nor the Harenbrock PGPUB 2003/0121860 is prior art.

Furthermore, it is submitted that claim 18 patentably defines over both the disclosure and the claims of Harenbrock '571 and the PGPUB because the last two lines of claim 18 require the container to be mounted directly to the filter housing such that the container and filter housing are in direct contact with each other. Applicants submit that this language

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clearly defines over Harenbrock because Harenbrock's container (Fig. 1) is separated by a large distance from fuel filter 6 and it would not have been obvious to mount the container directly to the filter as now required by claim 18 and its dependent claims. Note that claim 25 has been canceled in response to the examiner's suggestion and also because it was inconsistent with claim 18 as presently amended.

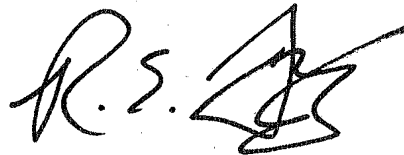
Claims 18-20, 32, 38-39, and 41 stand rejected under 35 USC 102(b) as anticipated by Kasten (3368681) or alternatively under 35 USC 103(a) as obvious over Kasten '681 in view of Kasten (2864505). According to the rejection, tank 16 of Kasten '681 corresponds to applicants' claimed "container." In view of the amendment to the last two lines of claim 18, it is submitted that claim 18 now clearly defines over Kasten '681 alone or in combination with Kasten '505 because neither one discloses a container that is mounted directly to the filter housing such that the container and filter housing are in direct contact with each other. Furthermore, it would not have been obvious to mount Kasten's tank 16 to fuel filter 14. Accordingly, the examiner is requested to withdraw this rejection.

The remaining rejections of dependent claims are all based on Harenbrock '571, JP '606, or Kasten '681 discussed above. Thus, it is submitted that the remaining rejections should be withdrawn for reason previously set forth.

Appl. No. 10/540,943
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Accordingly, it is respectfully requested that the examiner withdraw all of the rejections and allow all of the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. E. Greigg', with a stylized flourish at the end.

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